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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/402,362 | 10/04/1999 | MARJORIE GAN VALIX | 23999 | 5836 |

7590 09/10/2002

NATH & ASSOCIATES
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WASHINGTON, DC 20005

EXAMINER

MADSEN, ROBERT A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1761

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/402,362

Applicant(s)

VALIX, MARJORIE GAN

Examiner

Robert Madsen

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The rejection of claims 2-9, 12,13,15 and 16 made under 35 U.S.C. 103(a) as being unpatentable over Wilder et al. (US 2703807) in view of Aria et al. (JP 406200289A), Juinichi (JP07011285), Linden et al. (US 2662907), Feuge et al. (US 2802844), and Cheng et al. (US 5374751) stands.

The rejection of claims 10,11, and 14 made under 35 U.S.C. 103(a) as being unpatentable over Wilder et al. (US 2703807) in view of Aria et al. (JP 406200289A), Juinichi et al. (JP07011285), Linden et al. (US 2662907), Feuge et al. (US 2802844), and Cheng et al. (US 5374751), further in view of Hilfman stands.

The rejections of claims 17 and 18 made under 35 U.S.C. 103(a) as being unpatentable over Synosky et al.(H1241), Miguel-Colombel et al. (US 5882657, and Lake (US 3931258) stands.

Response to Arguments

Applicant's arguments filed June 14, 2002 have been fully considered but they are not persuasive. Applicant argues that the references do not teach deresination, browning effects from Maillard reaction, removal of phosphates, etc. However, in response it is noted that these features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, applicant is reminded that

in a claim drawn to a process of making, the intended use must result in a *manipulative difference* as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). As currently recited the method claims do not include any limitation stating a particular benefit resulting from the particular steps. Thus, the claims are interpreted as steps for any purpose, regardless of the *intended* purpose.

As cited in the office action of January 14, 2002, the primary reference, Wilder '807, teaches the *recited* method steps (i.e. heating crude wax in iso-propanol to remove pitch from the wax) except for the step of repeating the separation steps and removing any residual peroxides from the wax after treatment with the oxygen gas. However, these are conventional steps known in the prior art for accomplishing the same goal as Wilder '807. With respect to repeating the steps, the purpose of Wilder '807 is to purify sugar cane wax, and the other references, such as Arai et al., Junichi et al. , Linden, teach repeating the separation steps for purifying sugar cane wax. Feuge who teaches a similar purification method applied to a natural wax, includes repeating the separation steps, and further teaches the conventional need to remove peroxides after an oxidizing step. Thus it is obvious to combine the references since they are trying to accomplish the same goal as Wilder: extracting a purified wax from a crude wax.

With respect to the arguments directed to claims 17 and 18, any composition that comprises these components meets the limitation of these claims. Applicant is reminded, "[E]ven though product-by-process claims are limited by and defined by the

process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is *unpatentable even though the prior product was made by a different process.*" (In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (703)305-0068. The examiner can normally be reached on 7:00AM-3:30PM M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703)308-3959. The fax phone numbers


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for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0061.


Robert Madsen
Examiner
Art Unit 1761
August 28, 2002


MILTON I. CANO
SUPERVISORY PATENT EXAMINER
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